



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/262,506	03/02/1999	MARK W. PERLIN	PERLIN-3CONT	9473

7590 04/08/2002  
ANSEL M. SCHWARTZ  
ONE STERLING PLAZA  
STE 304  
201 N CRAIG STREET  
PITTSBURGH, PA 15213

EXAMINER

ZEMAN, MARY K

ART UNIT	PAPER NUMBER
----------	--------------

1631

DATE MAILED: 04/08/2002

14

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/262,506

Applicant(s)

PERLIN, MARK W.

Examiner

Mary Zeman

Art Unit

1631

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 32-38 is/are pending in the application.
- 4a) Of the above claim(s) 32 and 33 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 34-38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Art Unit: 1631

### DETAILED ACTION

Claims 32-38 are pending in this application. Claims 16-31 have been canceled. Claims 32 and 33 stand withdrawn from consideration as being drawn to a non-elected invention.

This application contains claims 32 and 33 drawn to an invention nonelected with traverse in Paper No. 6. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Applicant's arguments filed 4/16/01, 8/27/01 and 11/7/01 have been fully considered but they are not persuasive. Any rejection not reiterated below has been withdrawn.

### Rejections Maintained

Claims 34-38 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-16 of U.S. Patent No. 5,541,067. Although the conflicting claims are not identical, they are not patentably distinct from each other because the method steps of the '067 patent meet the limitations of the pending claims in the present application. The claims of the patent are directly drawn to methods of genotyping a nucleic acid sample, wherein a polynucleotide repeat region is amplified, characterized, and used to produce a genotype of that location. Applicant has provided no specific arguments regarding these rejections.

Claims 34-38 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-22 of U.S. Patent No. 5,580,728. Although the conflicting claims are not identical, they are not patentably distinct from each other because the methods of the patent fall within the scope of the instant invention. . The claims of the patent are directly drawn to methods of genotyping a nucleic acid sample, wherein a polynucleotide repeat region is amplified, characterized, and used to produce a genotype of that location. Applicant has provided no specific arguments regarding these rejections.

Claims 34-38 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-30 of U.S. Patent No. 5,876,933. Although the conflicting claims are not identical, they are not patentably distinct from each other because

Art Unit: 1631

the methods of the patent fall within the scope of the instant invention. . The claims of the patent are directly drawn to methods of genotyping a nucleic acid sample, wherein a polynucleotide repeat region is amplified, characterized, and used to produce a genotype of that location. Applicant has provided no specific arguments regarding these rejections.

### *New Grounds of Rejection*

#### *Claim Rejections - 35 USC § 112*

Claims 34-38 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. *This is a new grounds of rejection necessitated by Applicant's amendments.* It is noted that Applicant has filed no specific arguments in regard to the previous rejections under this statute.

In claim 34, one does not actually physically produce an allele by the claimed method steps. One can *identify* an allele or genotype based upon the information obtained and analyzed.

In claim 37 it is entirely unclear where this limitation is to be added to the method. There is no indication that the nucleic acid sample is from a particular individual, or that the process claimed is linked to any particular individual such that the limitation of claim 37 can be performed.

Claim 38 appears to have a typographical error, in that "comprising an allele with another allele" should read "comparing an allele with another allele." If this is not an error, it is entirely unclear how one can *comprise* one allele with another.

### *Conclusion*

No claim is allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after

Art Unit: 1631

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary K Zeman whose telephone number is (703) 305-7133. The examiner can generally be reached between the hours of 7:00 am and 1:00 pm Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, can be reached at (703) 308-4028.

Official fax numbers for this Art Unit are: (703) 308-4242, (703) 872-9306. An *unofficial* fax number, direct to the Examiner is (703) 746 5279. Please call prior to use of this number.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the TC1600 Receptionist whose telephone number is (703) 308-0196.

mkz  
4/4/02

  
MARY K. ZEMAN  
PRIMARY EXAMINER  
